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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/764,149      01/19/2001      Eberhard Nieschlag      PLOVIN-3A      8178

23599      7590      12/21/2001

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EXAMINER

BENNETT, RACHEL M

ART UNIT

PAPER NUMBER

1615

DATE MAILED: 12/21/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/764,149

Applicant(s)

NIESCHLAG ET AL.

Examiner

Rachel M. Bennett

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### **DETAILED ACTION**

The Examiner acknowledges receipt of Information Disclosure Statement filed 8/30/01 and Preliminary Amendment A filed 1/9/01.

#### ***Oath/Declaration***

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not include a name, the residence, post office address and citizenship of the 12<sup>th</sup> inventor and is missing the signature of the 6<sup>th</sup> inventor.

#### ***Specification***

2. The disclosure is objected to because of the following informalities: Page 20, Table 1 of the present specification is not legible. It is requested that Applicant replace said page with a legible copy of Table 1.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Regarding claims 5, 7, 8, 10, 15, 16, 19 and 20, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

5. Regarding claims 2, 6 and 15, the phrase "particularly" or "in particular" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention.

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6. Claims 42-49 provides for the use of NET for the preparation of a pharmaceutical composition, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 42-49 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-5, 7-21, 42-56 are rejected under 35 U.S.C. 102(b) as being anticipated by Guerin et al.

Guerin discloses the combination of progestagens and androgens and its use for male contraception (see abstract and entire article). The reference teaches progestagens such as

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medroxyprogesterone acetate and norethisterone and androgens such as testosterone and testosterone undecanoate (see page 188, lines 14-22). The reference also teaches (1) both steroid classes can be administered by intramuscular injections; (2) azoospermia or oligozoospermia are obtained (see page 188, lines 4-8) and (3) the use of various amount of each active agent.

Therefore, these claims are anticipated.

10. Claims 1-4, 7-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Spona et al. (US 5583129).

Spona discloses the combination of an estrogen and a gestagen and its use as a contraceptive agent in females (see col. 3, lines 5-30). The reference teaches (1) various gestagens such as norethisterone and norgestimate and (2) various amount of each active agent. Therefore, these claims are anticipated.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1-56 rejected under 35 U.S.C. 103(a) as being unpatentable over Guerin et al.

Guerin, as disclosed above, teaches the combination of progestagens and androgens and its use for male contraception.

The instant claims differ from the reference by reciting various dosages of the active ingredient(s). However, the preparation of various pharmaceutical formulations having various amounts of the active agent is within the level of skill of one having ordinary skill in the art at

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the time of the invention. It is also been held that the mere selection of proportions and ranges is not patentable absent a showing of criticality. *In re Russell*, 439 F.2d 1228, 169 USPQ 426 (CCPA 1971).

13. Claims 1-10, 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spona et al. (US 5583129).

Spona, as disclosed above, teaches the combination of an estrogen and a gestagen and its use as a conceptive agent in females (see col. 3, lines 5-30).

The instant claims differ from the reference by reciting various doses of the active ingredients(s) and administration by non-oral routes. However, the preparation of various pharmaceutical formations having various amounts of the active of the active agent is within the level of skill of one having ordinary skill in the art at the time of the invention. It is also been held that the mere selection of proportions and ranges is not patentable absent a showing of criticality. *In re Russell*, 439 F.2d 1228, 169 USPQ 426 (CCPA 1971). Thus, it is within the level of skill of one having ordinary skill in the pharmaceutical art to make a non-oral pharmaceutical preparation comprising various amounts of active ingredients taught by the prior art with the reasonable expectation that said preparation would be useful as taught by Spona.

### *Correspondence*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel M. Bennett whose telephone number is (703) 308-8779. The examiner can normally be reached on Monday through Friday, 8:00 A.M. to 4:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on (703) 308-2927. The fax phone numbers for the

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organization where this application or proceeding is assigned are (703) 305-3592 for regular communications and (703) 309-7924 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

R. Bennett: RMB *RMB*  
December 19, 2001

THIRMAN K. PAGE  
SUPERVISORY PATENT EXAMINER  
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